REMARKS/ARGUMENTS

The rejections presented in the Office Action dated July 14, 2006 (hereinafter Office Action) have been considered. Claims 1-51 and 53-54 remain pending in the application after amendment. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

All pending claims stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,709,331 to *Berman.* A terminal disclaimer is provided herewith to address the obviousness-type double patenting rejection. Reconsideration of the pending claims in view of the terminal disclaimer is respectfully requested.

Claims 1-8, 11-26, 29, 30, 40, 41, 43, 45-50 and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,203,428 to Giobbi *et al.* (hereinafter "*Giobbi*"). The Applicant respectfully traverses the rejection.

Without acquiescence to particular correlations of claims and the *Giobbi* reference, independent Claims 1, 30, 40 and 50 have been amended to facilitate prosecution of the application. Claim 52 has been canceled without prejudice or disclaimer. Regarding independent Claims 1, 30, 40 and 50, these claims have been amended to be directed to slot games that include symbol combinations, such as those involving mechanical or electronic reels. For example, Claim 1 has been amended to be directed to slot games, where each of the gaming activity sets involves a discrete spin event(s) of that slot game, and where outcomes are generated based on resulting symbol combinations of the spin event(s). *Giobbi* does not describe any features in connection with such slot games. To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that *Giobbi* does not teach every

element of Claim 1, and therefore fails to anticipate Claim 1 under 35 U.S.C. §102(e). Independent Claims 30, 40 and 50 have been amended in an analogous fashion, and thus *Giobbi* also fails to anticipate these claims. Withdrawal of the rejection to these claims on these grounds is respectfully solicited.

Dependent Claims 2-8, 11-26 and 29 are dependent from independent Claim 1, and dependent Claims 41, 43 and 45-49 are dependent from independent Claim 40. These dependent claims also stand rejected under 35 U.S.C. §102(e) as being unpatentable over *Giobbi*. While Applicant does not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency, it is believed that these rejections are moot in view of the remarks made in connection with independent Claims 1 and 40. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2-8, 11-26, 29, 41, 43 and 45-49 are also not anticipated by *Giobbi*.

Claims 27, 28, 31-39, 53 and 54 stand rejected under 35 U.S.C. §103(a) as being obvious over *Giobbi* in view of U.S. Patent No. 5,800,269 to Holch (hereinafter "*Holch*"). The Applicant respectfully traverses the Examiner's rejections.

The Examiner has indicated that *Giobbi* fails to describe receiving an indication of a maximum number of the gaming activity sets supportable by an accumulated credit total. The Examiner cites *Holch* as describing a device that tracks a player's account to ensure sufficient funds are available to cover a selected wager. *Holch* is directed to a coinless video game (Abstract), and is used to determine whether a player's electronic account has sufficient funds to make a particular wager. It is respectfully submitted that *Holch* determines only whether sufficient funds are available for a particular wager, and does not calculate the number of slot game events available for aggregate play based on an expenditure of an accumulated credit total. For example, Claim 27 involves receiving an indication of the maximum number of gaming activity events of a slot game that the aggregate play will include if all available credits are allocated to the aggregate play. It is respectfully submitted that *Holch* merely keeps track of the user's account balance, and allows or disallows a particular wager to be made based on the

account balance. It does not teach or suggest calculating the quantity of slot game events that may be played based on a credit total.

As *Giobbi* does not teach or suggest anything regarding such a determination, and because *Holch* also fails to teach or suggest at least the claimed feature of Claim 27, a combination of *Giobbi* and *Holch* necessarily fails to teach or suggest every limitation set forth in Claim 27. Thus, the Applicant respectfully contends that the Examiner has failed to establish *prima facie* obviousness based on the combination of references of *Giobbi* and *Holch* under 35 U.S.C. §103(a), as the cited combination fails to teach or suggest all the claim limitations as required under M.P.E.P. § 2143. For at least this reason, dependent Claim 27 is not rendered obvious by the combination of *Giobbi* and *Holch*. Claim 28 is dependent from Claim 27, and thus the combination of *Giobbi* and *Holch* fails to render dependent Claim 28 obvious as well.

Claim 31 is dependent from independent Claim 30. Claim 31 involves receiving an accumulated credit quantity for the aggregate play, and converting that quantity to a number of slot game events supportable by that quantity. Independent Claim 32 similarly involves receiving an accumulated credit quantity for the aggregate play, and determining the number of gaming activity sets that are supported by that particular credit quantity. As indicated above in connection with Claim 27, *Giobbi* is silent in this regard, and *Holch* merely keeps track of the user's account balance, and allows or disallows a particular wager to be made based on the account balance. It does not teach or suggest determining any ***quantity*** of slot game events that may be played based on a credit total. Thus, a combination of *Giobbi* and *Holch* similarly fails to teach or suggest all the claim limitations of Claim 31 or Claim 32, as the combination fails to teach at least the limitations of converting or determining such a credit quantity (*e.g.*, $100) to a quantity of slot game events (*e.g.*, 50 slot game events). Thus, the Applicant respectfully contends that the Examiner has failed to establish *prima facie* obviousness based on the combination of references of *Giobbi* and *Holch* under 35 U.S.C. §103(a), as the cited combination fails to teach or suggest all the claim limitations as required under M.P.E.P. § 2143.

Dependent Claims 33-39, which are dependent from independent Claim 32, were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Giobbi* and *Holch*. While Applicant does not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or

what may be otherwise well-known in the art, it is believed that these rejections are now moot in view of the remarks made in connection with independent Claim 32. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 33-39 are also allowable over the combination of *Giobbi* and *Holch*.

Another requirement for establishing *prima facie* obviousness based on a combination of references is that there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (M.P.E.P. § 2143). The Examiner's proffered motivation merely sets forth results if the references were indeed combined, and does not provide any motivation for actually combining them. For example, regarding Claim 28, the Examiner's proffered motivation to combine the *Giobbi* and *Holch* references is "to provide a gaming system to determine whether the number of gaming activity sets selected by the player is supportable by the available credit total to prevent games from starting without sufficient funding, which would diminish casino profits." Respectfully, this is a statement made entirely with the benefit of hindsight of the present invention. There must be some actual *motivation* to combine the references, found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest *the combination*. Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.* The Applicant respectfully submits that there is no clear and particular evidence provided in the Office Action to combine the *Giobbi* and *Holch* references. For at least this additional reason, the Applicant contends that *prima facie* obviousness has not been established.

Claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being obvious over *Giobbi* in view of U.S. Patent No. 6,312,334 to Yoseloff (hereinafter "*Yoseloff*"). The Examiner relies on *Giobbi* as teaching all of the elements of Claim 1, from which Claims 9 and 10 depend. As indicated above, the Applicant disagrees that *Giobbi* teaches all the limitations of Claim 1, particularly as amended. Thus, the Applicant disagrees that *Giobbi* teaches all the features of Claims 9 and 10 indicated in the Office Action as being taught by *Giobbi*. Further, *Yoseloff*'s alleged teaching of advancing to a bonus round does not, even if combined with *Giobbi*, ultimately teach that a bonus round provides a predetermined number of gaming activity sets to be included in an aggregate play mode. For example, *Yoseloff* does not teach or suggest any bonus round where a number of gaming activity sets are indicated to a system such as *Giobbi* to indicate a number of games to be included in an aggregate play. Because a combination of *Giobbi* and *Yoseloff* fails to teach or suggest all the limitations of Claims 9 or 10, *prima facie* obviousness is not established, and the Applicant respectfully requests withdrawal of the rejection.

Further, the proffered motivation to combine *Giobbi* and *Yoseloff* is "to enhance a player's interest by offering free plays in order to increase the amount of time spent by player's at the gaming device and thereby increasing the operator's revenues." The Applicant respectfully submits that this proffered *motivation* could be applied to any and every gaming machine in the global casino market. This does not rise to the level of "clear and particular evidence" of motivation to combine as is required by the Federal Courts. For at least this additional reason, the Applicant contends that *prima facie* obviousness has not been established, and withdrawal of the rejection to Claims 9 and 10 is respectfully solicited.

Claims 42 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Giobbi* in view of U.S. Patent No. 6,369,727 to Vincze (hereinafter "*Vincze*"). The Applicant respectfully traverses the rejection. The Examiner relies on *Giobbi* as teaching all of the elements of Claim 40, from which Claims 42 and 44 depend. As indicated above, the Applicant disagrees that *Giobbi* teaches all the limitations of Claim 40, particularly as amended. Thus, the Applicant disagrees that *Giobbi* teaches all the features of Claims 42 and 44 indicated in the Office Action as being taught by *Giobbi*. Further, *Vincze*'s alleged teaching of RNGs does not remedy the deficiencies of *Giobbi*, which is directed to slot games involving results based on

symbol combinations. A combination of *Giobbi* and *Vincze* fails to teach or suggest all of the claim limitations of Claims 42 and 44 as pending.

Additionally, the proffered motivation to combine *Giobbi* and *Vincze* is to "meet increased demand for random numbers in a game device and thereby provide faster game results." The Applicant respectfully submits that this proffered *motivation* does not rise to the level of "clear and particular evidence" of motivation to combine as is required by the Federal Circuit precedent. For at least this additional reason, the Applicant contends that *prima facie* obviousness has not been established, and withdrawal of the rejection to Claims 42 and 44 is respectfully solicited.

Claim 51 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Giobbi* in view of U.S. Patent No. 6,220,959 to Holmes, Jr. *et al.* (hereinafter "*Holmes*"). The Applicant respectfully traverses the rejection. Without acquiescence to the particular rejections to Claim 51, Claim 51 has been amended to more clearly indicate a reel-type slot game involving paylines, which involves the aggregate play feature. Neither *Giobbi* nor *Holmes* are directed to slot games involving reels and symbol combinations. A combination of *Giobbi* and *Holmes* thus fail to teach or suggest all of the claim limitations of Claim 51, and thus *prima facie* obviousness is not established. Reconsideration and withdrawal of the rejection to Claim 51 is respectfully solicited.

Authorization is given to charge Deposit Account No. 50-3581 (KING.001C1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at to discuss any issues related to this case.

Respectfully submitted,

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